



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

Applicant : R. G. Hartmann, et al.
Serial No. : 09/344,323
Filed : 24 June 1999

Examiner : Hai V. Nguyen
Group : 2142

Entitled : System and Method for Variable Size Retrieval of
Webpage Data
Docket No. : END919980070US1

Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

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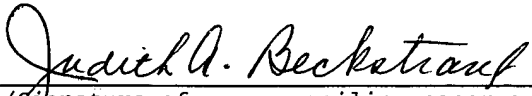
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Docket No. END919980670051

PATENT

AC/2142
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: R. G. Hartmann, et al.

Application No.: 09/344,323 Group No.: 2142

Filed: 24 June 1999 Examiner: Hai V. Nguyen

For: System and Method for Variable Size Retrieval
of Webpage Data

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 C.F.R. § 1.192)**

1. TRANSMITTAL

Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on 15 July 2004.

2. STATUS OF APPLICANT

This application is on behalf of other than a small entity.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Mail Stop Appeal Brief - Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name: Judith A. Beckstrand

Date: 13 July 2004

Signature:

Judith A. Beckstrand

Docket No. **END919980070US1**

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is \$330.00 for other than a small entity.

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply. Applicant believes that no extension of term is required. However, if an extension of term is required, please consider this a petition therefor.

5. TOTAL FEE DUE:

The total fee due is:

Appeal brief fee	\$ 330.00
Extension fee (if any)	\$ _____


Total Fee Due:	\$_330.00
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6. FEE PAYMENT:

Charge IBM Deposit Account No. 09-0465 the sum of \$ 330.00.
A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

This is a request to charge IBM Deposit Account No. 09-0465 for any required additional extension and/or fee, or for any required additional fee for claims.

 13 Sep 2004
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Docket No. END919980070US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: R. G. Hartmann, et al.

Application No.: 09/344,323 Group No.: 2142

Filed: 24 June 1999 Examiner: Hai V. Nguyen

For: System and Method for Variable Size
Retrieval of Webpage Data

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal,
filed in this case on 15 July 2004.

The fees required under 37 C.F.R. §1.17, and any
required petition for extension of time for filing this
brief and fees therefor, are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

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Name: JUDITH A. BECKSTRAND

Date: 13 Sep 2004

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Appellant's Brief

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This brief is transmitted in triplicate.

This brief contains these items under the following headings, and in the order set forth below:

- I REAL PARTY INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF INVENTION
- VI ISSUES
- VII GROUPING OF CLAIMS
- VIII ARGUMENTS
 - ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH
 - ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH
 - ARGUMENT: VIIIC REJECTIONS UNDER 35 U.S.C. 102
 - ARGUMENT: VIIID REJECTIONS UNDER 35 U.S.C. 103
 - ARGUMENT: VIIIE REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112
- IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
 - OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

The final page of this brief bears the practitioner's signature.

I REAL PARTY INTEREST

The real party in interest in this appeal is International Business Machines Corporation, Armonk, New York.

II RELATED APPEALS AND INTERFERENCES

No other appeals or interferences will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-20

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: None

2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-20
4. Claims allowed: None
5. Claims rejected: 1-20

C. CLAIMS ON APPEAL

The claims on appeal are: 1-20

IV STATUS OF AMENDMENTS

The status of any amendment filed subsequent to the final rejection is, insofar as understood by appellant, as follows:

The amendment filed 2 June 2004, subsequent to the final rejection of 2 April 2004, was entered as noted in the

advisory action of 9 July 2004.

V SUMMARY OF INVENTION

A system, browser, method or program storage device for operating a client browser [20] for requesting a data file [29] from a server [10], by receiving data parameters consisting only of one or both of data type [Figures 5, 6 or 7: data type image 52, or video 54, or audio 56, or text 58] and size [Figures 5, 6 or 7: minimum size 80, 82, 84, 86; maximum size 90, 92, 94, 96] from a browser user [user terminal 21] to establish predefined configuration parameters (page 10, lines 9-19; and page 12, line 13); and thereafter [page 6, lines 5-7], communicating to said server a head request [Figure 2; Figures 4 and 8, step 30]; receiving from said server in response to said head request a data file header [Figure 3; Figures 4 and 8, step 32] describing data file parameters including data type [Figure 3, field 27] and size [Figure 3, field 28]; determining [Figure 4, step 34] if said data file parameters [27, 28] are within said predefined configuration parameters [Figures 5-7]; and only if so [page 6, line 11; Figure 4, steps 36 and 38], communicating to said server a get request [Figure

2, request message 12] requesting said server to serve
[Figure 3, response message 14] said data file [29].

VI ISSUES

Whether claims 1-20 are unpatentable under 35 U.S.C.
103 over Albers et al. (U.S. Patent 6,223,188 B1) in view of
Ball et al. (U.S. Patent 6,366,933 B1).

VII GROUPING OF CLAIMS

Claims 1-20 stand or fall together.

VIII ARGUMENTS

REJECTIONS UNDER 35 U.S.C. 103

Claims 1-20 have been rejected under 35 U.S.C.
103(a) over Albers, et al. in view of Ball, et al.

Prima Facie Case of Obviousness

Appellants argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. [See *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997)]. That a claimed invention may employ known principles does not itself

establish that the invention would have been obvious, particularly where those principles are employed to deal with different problems. The Examiner must consider the claim as a whole, and not piece together the claimed invention using the claims as a guide. The Federal Circuit has stated: "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. [See *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)].

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the Examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the

relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A rejection under 35 U.S.C. § 103 must be based on whether there is a teaching, motivation, or suggestion to select and combine the references based on objective evidence of record. Therefore, the Examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996).

Neither Albers nor Ball Teach, as Appellants Claim, a
Predetermined, User Defined Configuration of Profile
Consisting of Data Type and/or Size

In the case of Ball, a HEAD command is used to retrieve the Last-Modified field from a W3 document for use in deciding when a page has been changed. (See Ball, Col. 11, lines 62-64 and Col. 12, lines 35-46). Ball's versioning is determined at the server, and is not based on a profiled or predetermined configuration set up by the customer, and the

threshold is based on date of last visit, not type or size of the file.

The Examiner refers to Albers, col. 1 lines 41-67, col. 2 lines 1-51 and col. 7 line 39 to col 8. line 21, stating that therein is taught "...a method for operating a client browser for requesting a data file from a server, comprising the steps of: receiving data parameters consisting only of one or both of data type and size from a browser user to establish predefined configuration parameters." Appellants traverse this characterization of Albers.

In the case of Albers, when a user cursor hovers over a link, information regarding what is on that link is displayed to the user, who must then decide whether or not to download the linked material. As Albers teaches, "Once the user begins viewing such a document, the system selects a set of links in that hypermedia document. For example, the selection process may be controlled by user selection or predefined parameters, or the system may simply select all links currently displayed." (Albers, col. 8, lines 17-21).

Albers does not teach that such "predefined parameters" are data type and size. Albers does teach (see Figure 7, at

steps 730 and 740) that the system indicates to the User a data file type and size. However, Albers does not teach that the user first input data file type and size to establish predefined parameters which will be used by the browser to determine, based on the server's response to a head request, whether or not the browser should issue a request for the full data file. The important distinction between appellants' claimed invention and the teachings of Albers is that in Albers information is presented to the user to act on, whereas in appellants' invention the decision is made based on configured values.

The Examiner refers to Albers Figures 9 and 10, and Col. 9, lines 39-60 and Col. 10, lines 8-21, asserting that Albers is here teaching the concept of "a predetermined, user defined configuration parameters". But this does not reach to appellants claims, which clearly state that the predetermined, user defined configuration parameters consist of file type and/or size.

Neither Albers or Ball teach that the user inputs file type and/or size to predefine configuration parameters which will be used by the browser together with data received from a server in response to a head request to determine whether

or not to issue a get request, and to do so without further user input.

Albers teaches providing size and type information via visual or sound queues to a user who must then determine whether to download the linked-to file. Ball teaches a threshold based on date.

Independent claims 1, 2, and 11-17 are directed to the concept of predefining configuration parameters based on user input consisting only of one or both of data size and data type and of using the HEAD request to determine from the file header the file size and type AND THEN ONLY WHEN the file size and file type match the predefined configuration parameters issuing a GET request to download the data portion of the file.

The Asserted Motivation to Combine Albers and Ball is Based
on Hindsight

The Examiner provides as the motivation for combining Albers and Ball, the following:

"However, Albers does not explicitly disclose

responsive to said browser determining from said data file header that said data file data type and size are in accordance with said request for data, receiving from said browser a GET request, said browser responsive to predetermined configuration, consisting only of one or both of said data file data type and said size, not being in accordance with said request for data, not issuing said GET request to said server; and thereafter responsive to said GET request, serving to said browser data corresponding to said header.

Thus the artisan would have been motivated to look into the related network arts for potential methods and systems for implementing the servicing the browser user's requests for resources or objects over the Internet." [Emphasis added].

First, the Examiner is here using appellants own teachings to provide the motivation. The Examiner recites appellants claim, and then states "Thus the artisan would have been motivated..." The antecedent of "thus" is appellants' own teaching! It is well established that the motivation to combine must come from the prior art references.

Second, the Examiner states that the artisan is motivated to look for "potential methods and systems for implementing the servicing the browser user's requests for resources..." This is not what appellants are claiming, and that the Examiner could find such in the Ball reference has no relationship whatsoever to appellants claims. Certainly, neither Ball nor Albers teach, as appellants' claims all variously recite, that a browser user predefine configuration parameters consisting of one or both of file type and file size, which parameters are compared in the browser with the file type and size received from a server in response to a HEAD request from a browser to determine at the browser whether or not to submit a GET request to the server to obtain the full data file.

Appellants respectfully assert that neither Albers nor Ball teach, nor in combination teach, the invention set forth in claims 1-20, and urges that the Examiner's final rejection of these claims under 35 U.S.C. 103(a) be reversed.

IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1 1. A method for operating a server responsive to a request
2 for data from a user of a client browser specifying
3 predefined configuration parameters comprising one or both
4 of data type and size, comprising the steps of:

5 receiving from said browser a head request for the
6 header of a data file;

7 responsive to said head request, serving to said
8 browser data file header information including data
9 file data type and size;

10 responsive to said browser determining from said data
11 file header that said data file data type and size are
12 in accordance with said request for data, receiving
13 from said browser a get request, said browser
14 responsive to said predefined configuration parameters,
15 consisting only of one or both of said data file data
16 type and said size, not being in accordance with said
17 data file header information, not issuing said get
18 request to said server; and thereafter

19 responsive to said get request, serving to said browser

20 data corresponding to said header.

1 2. [Previously amended] A method for operating a client
2 browser for requesting a data file from a server, comprising
3 the steps of:

4 receiving data parameters consisting only of one or
5 both of data type and size from a browser user to
6 establish predefined configuration parameters; and
7 thereafter,

8 communicating to said server a head request;

9 receiving from said server in response to said head
10 request a data file header describing data file
11 parameters including data type and size;

12 determining if said data file parameters are within
13 said predefined configuration parameters; and only if
14 so,

15 communicating to said server a get request requesting
16 said server to serve said data file.

1 3. The method of claim 2, wherein said predefined
2 configuration parameters define the data type and data size
3 acceptable to said user and wherein said data file
4 parameters include the data content type and data content
5 size of said data file.

1 4. The method of claim 3, wherein said data file comprises
2 a plurality of data files including one or more inline
3 documents.

1 5. The method of claim 4 wherein each of said plurality of
2 data files is of a type selected from the set of data file
3 types including image data, video data, audio data, and text
4 data.

1 6. The method of claim 5, wherein a head request is
2 submitted separately for each said inline document.

1 7. The method of claim 6, wherein said get request is

2 submitted selectively only for those inline documents having
3 data parameters within said predefined configuration
4 parameters.

1 8. The method of claim 3, wherein said predefined
2 configuration parameters include a maximum data size and a
3 minimum data size acceptable to said user.

1 9. The method of claim 2, responsive to said data file
2 parameters not being within said predefined configuration
3 parameters, comprising the further step of providing to said
4 user the option of modifying said user data parameters.

1 10. The method of claim 2, responsive to said data file
2 parameters not being within said predefined configuration
3 parameters, comprising the further step of providing to said
4 user the option of requesting a portion of said data file.

1 11. A server computer system, comprising:

2 a first logic element of said computer system for
3 receiving from a client browser a head request for a
4 header only of a data document;

5 a second logic element of said computer system
6 responsive to said head request for serving to said
7 client browser a data document header including data
8 type indicia and data size indicia;

9 a third logic element of said computer system for
10 receiving from said browser a get request responsive to
11 said browser determining that said data type indicia
12 and data size indicia match predefined configuration
13 parameters consisting only of one or both of data file
14 data type and data file size from a user request, said
15 browser blocking said get request in the event that
16 said data type indicia and said data size indicia do
17 not match said predefined configuration parameters; and

18 a fourth logic element of said computer system
19 responsive to said get request for serving to said
20 browser a data document corresponding to said header.

1 12. A server system including a digital computer, said
2 digital computer comprising:

3 first means for receiving from a client browser a head
4 request for a header of a data document;

5 second means responsive to said head request for
6 serving to said client browser a data document header
7 including data type indicia and data size indicia;

8 third means for receiving from said browser a get
9 request responsive to said browser determining that
10 said data type indicia and data size indicia match
11 predefined configuration parameters consisting only of
12 one or both of data type and data size specified in a
13 user request, said browser blocking said get request in
14 the event that said data type indicia and said data
15 size indicia do not match said predefined configuration
16 parameters; and

17 fourth means responsive to said get request for serving
18 to said browser a data document corresponding to said
19 header.

1 13. A client browser including a digital processor for
2 requesting a data file from a server, said digital processor
3 comprising:

4 means for receiving user specified data parameters
5 consisting only of one or both of data type and size
6 from a browser user to establish predefined
7 configuration parameters;

8 means for communicating to said server a head request;

9 means for receiving from said server in response to
10 said head request a data file header describing data
11 file parameters including data type and size;

12 means for determining if said data file parameters are
13 within said predefined configuration parameters; and
14 only if so,

15 means operable for communicating to said server a get
16 request requesting said server to serve said data file.

1 14. A program storage device readable by a machine,

2 tangibly embodying a program of instructions executable by a
3 machine to perform method steps for operating a client
4 browser for requesting a data file from a server, said
5 method steps comprising:

6 receiving user data parameters consisting only of one
7 or both of data size and type from a browser user to
8 establish predefined configuration parameters; and
9 thereafter

10 communicating to said server a head request;

11 receiving from said server in response to said head
12 request a data file header describing data file
13 parameters including data size and type;

14 determining if said data file parameters are within
15 said predefined configuration parameters; and only if
16 so,

17 communicating to said server a get request requesting
18 said server to serve said data file.

1 15. An article of manufacture comprising:

2 a computer useable medium having computer readable
3 program code means embodied therein for operating a
4 client browser for requesting a data file from a
5 server, the computer readable program means in said
6 article of manufacture comprising:

7 computer readable program code means for causing a
8 computer to effect receiving user specified data
9 parameters consisting only of one or both of data type
10 and data size from a browser user to establish
11 predefined configuration parameters;

12 computer readable program code means for causing a
13 computer to effect communicating to said server a head
14 request;

15 computer readable program code means for causing a
16 computer to effect receiving from said server in
17 response to said head request a data file header
18 describing data file parameters;

19 computer readable program code means for causing a

20 computer to effect determining if said data file
21 parameters are within said predefined configuration
22 parameters; and only if so,

23 computer readable program code means for causing a
24 computer to effect communicating to said server a get
25 request requesting said server to serve said data file.

1 16. A digital computer program element digitally stored in
2 a computer storage medium for operating a client browser for
3 requesting a data file from a server according to the steps
4 of:

5 receiving data parameters consisting only of one or
6 both of data type and size from a browser user to
7 establish predefined configuration parameters; and
8 thereafter

9 communicating to said server a head request;

10 receiving from said server in response to said head
11 request a data file header describing data file
12 parameters including data type and size;

13 determining if said data file parameters are within
14 said predefined configuration parameters; and only if
15 so,

16 communicating to said server a get request requesting
17 said server to serve said data file.

1 17. A program storage device readable by a machine,
2 tangibly embodying a program of instructions executable by a
3 machine to perform method steps for operating a server
4 responsive to a request for data from a client browser, said
5 method steps comprising:

6 receiving from said browser a head request for the
7 header of a data file;

8 responsive to said head request, serving to said
9 browser data file header information including data
10 type and data size;

11 receiving from said browser a get request responsive to
12 said browser determining that said data file is of a
13 data type and data size specified by a user prior to

14 said browser issuing said head request, said browser
15 blocking said get request in the event that said data
16 type indicia and said data size indicia do not match
17 predefined configuration parameters consisting only of
18 one or both of said data type and data size specified
19 by said user request; and thereafter

20 responsive to said get request, serving to said browser
21 data corresponding to said header.

1 18. The program storage device of claim 17, said method
2 steps further comprising responsive to said browser blocking
3 said get request of providing to said user the option of
4 modifying said data type and data size.


1 19. The program storage device of claim 17, said method
2 steps further comprising responsive to said browser blocking
3 said get request of providing to said user the option of
4 requesting a portion of said data file.

1 20. The program storage device of claim 17, said method
2 steps further comprising:

3 receiving from said browser data parameters defining

4 the data type and data size acceptable to said user,
5 wherein said data file parameters include the data
6 content type and data content size of said data file,
7 and wherein said data file comprises a plurality of
8 data files including one or more in-line documents.

13 Sep 2004


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